

REMARKS

Claims 1-15 and 17-20 are pending in the application.

Claims 1-15 and 17-20 have been rejected.

Claims 1, 4, 8, 13, 15 and have been amended, as set forth herein.

Claims 3, 12 and 19 have been canceled, without prejudice.

I. **REJECTIONS UNDER 35 U.S.C. § 103**

Claims 1, 2, 7-8, 10-11, 15 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee (US Patent 5,524,137) in view of Wilson (US Patent Application Publication 2004/0236574). Claims 3, 4, 12-14, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee (US Patent 5,524,137) in view of Wilson (US Patent Application Publication 2004/0236574) and further in view of Lor (US Patent 5,524,137). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781,

783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Applicant has amended independent Claims 1, 8 and 15 to recite substantially (Claim 1 only reproduced below):

identifying, through negotiation with the video client, a CODEC to be used to communicate with the video client; and

retrieving from memory the dynamic multimedia prompt having been encoded using the identified CODEC and stored in the memory thereafter, the dynamic multimedia prompt also having been encoded using a second CODEC different from the identified CODEC and stored in the memory.

Support for the claim amendments made herein may be found at least in the Applicant's Patent Application Publication 2005/0069105 at paragraphs 0029 and 0043-0044.

Applicant respectfully submits that none of the three cited references, either alone or in combination, teach, suggest or disclose these newly recited elements/features. Based on the Office Action's interpretation, Lor teaches a negotiation process for CODECs to be used by video clients

in a communication session. However, it does not appear that disclose or teaches encoding a multimedia prompt (all or a portion thereof) using one CODEC and storing, and encoding the same multimedia prompt using a different CODEC and storing, and after identifying which CODEC is going to be used by the video client, retrieving and corresponding stored prompt (of the two stored versions of the prompt). Therefore, Applicant's claim are not obvious in view of the cited references.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 1-2, 4-11, 13-15, 17-18, and 20.

II. NEW CLAIMS 21-23

New dependent Claims 21-23 have been added. For the same or similar reasons set forth above, Applicant respectfully submits these claims are patentable over the cited art.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

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